

REMARKS

Prior to this Amendment, claims 1, 25, and 28-45 were pending. With the entry of this Amendment, claim 39 will be allowed, claims 1, 25, 28, 30-38, and 40-45 will remain pending, and claims 2-24, 26-27, and 29 will be canceled.

35 U.S.C. § 112, 1st Paragraph

The Office rejected claims 1, 25, 28-38, and 40-45 under 35 U.S.C. § 112, 1st Paragraph, for failing to comply with the written description requirement, asserting that the specification as filed does not describe the full scope of the "recognition sequences" encompassed by the claims, but only describes the loxP recognition sequence. The Office further asserted that the specification as filed does not describe the full scope of the recombinases encompassed by the claims.

With respect to the first assertion, Applicants herein amend the claims to specify that the claimed recognition sequences are recombinase recognition sequences. Applicants, however, respectfully traverse the rejection based on the assertion that the written description requirement has not been satisfied with respect to the full scope of recombinases encompassed by the claims. Applicants assert that the disclosure indicates that Applicants invented and were in possession of the full scope of recombinases encompassed by the claims.

Determining whether the written description requirement is satisfied requires reading the disclosure in light of the knowledge possessed by those skilled in the art. The disclosure refers to the claimed recognition sequence as "a recognition sequence for a recombinase" (e.g., page 2, line 36-37; and page 7, lines 7-8). The disclosed recognition sequence serves the purpose of permitting the elimination of proviral

sequences that are no longer necessary after the provirus integrates into the host (page 2, lines 18-20). Moreover, the specification explicitly lists three of these, and states that they are non-limiting examples. The specification states that, in addition to the Crelox recombinase system, "other recombinase systems can also be used" (page 8, lines 29-30). The yeast FLP system and the bacterial R system are disclosed as two additional examples (page 8, lines 28-32). The relevant literature available at the time the invention was filed includes references that show multiple recombinases, including the FLP and R systems, were available and appropriate for use in eliminating proviral sequences that are no longer necessary after integration. Therefore, this disclosure supports Applicants' amended claims to a recognition sequence for a recombinase. Accordingly, Applicants respectfully request that the rejection based on 35 U.S.C. § 112, 1st Paragraph, be withdrawn.

35 U.S.C. § 102(b)

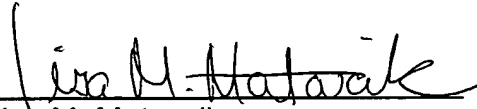
The Office rejected claims 1, 25, 28, 37, 40, and 44-45 under 35 U.S.C. § 102(b) as being anticipated by Gilboa et al. to the extent that the claims read on sequences that may be recognized by restriction enzymes or splicing factors. Applicants herein amend the claims to read on sequences that may be recognized by recombinases. Accordingly, this rejection may be withdrawn.

Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 6, 2004

By: 
Lisa M. Matovcik
Reg. No. 53,283